

REMARKS

Claims 1-24 and 26-28 are now pending in the application. Claims 1, 10, 13, 19 and 24 are amended. Claims 29-35 are newly added. The amendments and newly recited claims do not introduce new matter. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 5, 8, 9, 13, 16 and 21-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chaudhry (U.S. Pat. Pub. No. 2003/0086225) in view of Dienes et al. (U.S. Pat. Pub. No. 2004/0169970). This rejection is respectfully traversed.

Chaudhry and Dienes alone or in combination fail to show, teach or suggest a motor drive that has a surge protector with a gas discharge tube (GDT). The GDT has a trigger voltage that is greater than a hi-pot test voltage. The specification of the present invention refers to a hi-pot test voltage that is used in testing component integrity.

It is admitted by the Examiner on page 3 of the Office Action that Chaudhry fails to disclose the GDT as claimed. In Chaudhry the breakdown voltage of the GDT 72 is 425V, which refers to a surge voltage level. This is clearly different than a hi-pot test voltage described and claimed by Applicant. The breakdown voltage of Chaudhry is associated with surge protection during normal circuit use. On the other hand, the recited hi-pot test voltage is associated with the testing of a circuit prior to normal use, hence the recitation of the term "test".

The Examiner alleges that Deines discloses a GDT 24 with a trigger voltage that is greater than 1230 volts. Applicant submits that regardless of whether this is true, Deines fails to disclose the use of a GDT that has a trigger voltage equal to a hi-pot test voltage. As best understood by Applicant, Deines discloses the use of a gap arrester 24 that is used to protect a worker against an accidental energization of a distribution cable and/or a ground fault. Although Deines appears to disclose a range of breakdown voltages between 100V-10,000V, Denies does not address component, circuit, or appliance testing. For this reasons, Denies does not disclose the novel trigger voltage and/or voltage range claimed.

Also, Applicant submits that Deines is nonanalogous art. Referring to MPEP 2141.01(a), while the Patent Office classification of references and cross-references in the official search notes are some evidence of “nonanalogy” or “analogy” respectively, the court has found “the similarities and differences in structure and function of the inventions to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372, 177USPQ526, 527 (CCPA 1973). Also, Applicant submits that the structure, function, purpose, and setup of the safety device of Deines are clearly and substantially different than that of the present invention. Deines discloses a gap arrester that is used in a safety device to protect a worker against an accidental energization of a distribution cable and/or a ground fault. The gap arrester 24 is coupled between copper bars not between power supply lines. The device of Denies is used as a maintenance tool that is placed across terminals for worker protection. The claimed invention is directed to a surge protection circuit for an appliance. The surge protection circuit claimed protects an appliance with respect to a surge and allows for component and circuit testing.

Applicant agrees that GDTs exist and that GDTs may have various voltage trigger levels. However, Applicant submits that the use of a GDT, as claimed, to protect against surges and to allow for insulation testing is new and novel. Deines fails to disclose a motor drive or a surge circuit that is similar to that claimed. Deines would not have logically commended itself to the inventors' attention in considering the problems solved by the motor drive claimed. In developing a motor drive, one would not look to a gapped ground safety device to protect a worker. Thus, the Applicant submits that Deines is nonanalogous art and to use such reference is far reaching at best.

In addition, an advantage of the claimed invention is that when a surge occurs, the surge protector allows for current to flow from the input power lines, such as the live line, the second line, and the ground line, to continuously flow to ground. Chaudhry discloses the use of fuses that are serially coupled with GDTs, which when blown prevent current flow to ground. This in combination with a breakdown voltage of the GDTs of 425V would appear to teach away from the claimed invention. The claimed invention allows for current flow to, for example, an appliance at hi-pot test voltage levels and allows for current flow to ground for surge voltages that are greater than a hi-pot test voltage.

A reference must be considered for all that it teaches including disclosures that point towards the invention and disclosures that teach away from the invention. In re Dow, 5 USPQ.2d 1529 (Fed. Cir. 1988). It is improper to take teachings in the prior art out of context and give them meanings that they would not have to those skilled in the art. In re Wright, 9 USPQ.2d 1649 (Fed. Cir 1989). It is impermissible to pick and choose from a reference on so much of it as will support a given position to the

exclusion of other parts necessary to the full appreciation of what the reference fairly teaches to one skilled in the art. Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 230 USPQ 416 (Fed. Circ. 1986). Since the circuit of Chaudhry leads away from or more specifically is incapable of functioning and being used for the same purpose as the claimed invention, Chaudhry is not a proper reference to rely upon in rejecting claims 1 and 13. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Further Chaudhry does not simply provide an alternative, but rather fails to provide a circuit that can be used as the motor drive claimed. As a result, Chaudhry provides a different apparatus that functions differently than the claimed invention.

Obviousness must be determined at the time that the invention was made. 35 U.S.C. §103. The relevant prior art that should be considered is only that which he or she would have selected without the advantage of hindsight or knowledge of the invention. *Union Carbide Corp. v. American Can Co.*, 220 USPQ 584 (Fed. Circ. 1984). It is improper to use the inventor's disclosure as an instruction book on how to reconstruct the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). Both the suggestion and the expectation of success must be founded in the prior art and not in Applicant's disclosure. *In re Farrell*, 7 USPQ2d 1673 (Fed. Cir. 1988). It appears that the Examiner is using improper hindsight reasoning to modify and combine the relied upon references in this case.

It is a longstanding rule that to establish a prima facie case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 143 (CCPA 1974), see MPEP §2143.03. Since the references fail to teach or suggest each and every limitation of Claims 1 and 13, Claims 1 and 13 are novel, nonobvious and are in a condition for allowance.

Applicant respectfully asserts that the Examiner has failed to clearly and particularly support his alleged motivation to combine these references using actual evidence as required. According to established mandates of the patent laws, “[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP §2142. “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” MPEP §2143.01.

“The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The showing must be “clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002) (quoting *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)) (emphasis added). It is not sufficient to rely on “common sense and common knowledge,” as there must be specific evidence to support the motivation. *In re Lee*, 277 F.3d. 1338, 1344-45, 61 U.S.P.Q.2d

1430, 1434-35 (Fed. Cir. 2002)]. It is respectfully submitted that the Patent Office has not made a legally sufficient showing of a motivation to combine based on actual, specific, evidence.

Rather, according to MPEP §2142, “[t]o reach a proper determination under 35 U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art.” Furthermore, according to MPEP §2143.01, “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of [such modification].” *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Since the Patent Office has offered no proper support or motivation for combining the references, it is respectfully submitted that the rejection based on obviousness is clearly and unequivocally founded upon “knowledge gleaned only from applicant's disclosure.” MPEP §2145. Consequently, it is respectfully submitted that the rejection entails hindsight and is, therefore, improper.

Therefore, Claims 1 and 13 are allowable for at least the above reasons. Claims 2-9, 12, 14-18, 21-23, and 29-31 ultimately depend from Claims 1 and 13, respectively, and are allowable for at least similar reasons.

Claims 10 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holmquest (U.S. Pat. No. 5,619,105) in view of Chaudhry. This rejection is respectfully traversed.

Applicant submits that Holmquest and Chaudhry fail alone or in combination to shown, teach or suggest a motor drive with a live line, a second line and a ground line. The motor drive includes a rectifier, a first capacitor and a second capacitor. The first

capacitor is coupled between a first output of the rectifier and the second line. The second capacitor is coupled between a second output of the rectifier and the second line.

As best understood by Applicant, Holmquest discloses a rectifier circuit with inputs that are coupled to a transformer, which is coupled to a BLK and a WHT lines. Outputs of the rectifier of Holmquest are coupled to capacitors C2A and C2B, respectively. The capacitors C2A and C2B are not coupled between the rectifier circuit and the BLK or WHT lines.

Chaudhry fails to disclose the use of capacitors.

Therefore, Claims 10 and 19 are allowable for at least the above reasons. Claims 11 and 20 ultimately depend from Claims 10 and 19, respectively, and are allowable for at least similar reasons.

Claims 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Holzenthal in view of Deines. This rejection is respectfully traversed.

Holzenthal and Deines fail to show, teach or suggest a method of insulation testing an electric machine with a surge protection circuit as claimed. Holzenthal and Deines fail to show, teach or suggest a method that includes: A.) setting a trigger voltage of a GDT greater than a hi-pot test voltage; and B.) performing an insulation test.

As best understood by Applicant, Holzenthal discloses a transient voltage surge suppressor (TVSS) circuit that includes a fuse and a metal oxide varistor (MOV). Holzenthal does not disclose a GDT. The Examiner relies on Deines for the disclosure

of a GDT. As stated above, Deines fails to disclose a GDT that has a trigger set for a hi-pot test voltage.

Also, the Examiner alleges that Holzenthal discloses insulating testing and refers to paragraph [0017] of Holzenthal. In paragraph [0017], Holzenthal appears to disclose testing of MOVs, not insulating testing. Note that the present application is directed to the testing of circuitry other than MOVs, which are located within a surge protection circuit. The insulation testing referred to in claim 24 effectively removes MOVs when performing a test. For example, an MOV may be jumpered as described in the Background section of the present application. As another example, a MOV threshold voltage may be exceeded, thereby reducing the resistance of the MOV and allowing the testing of other circuit components. This is described in the specification. The recitation of a GDT as claimed allows for the insulation testing. Thus, the testing referred to in Holzenthal is not the same as or related to the testing claimed.

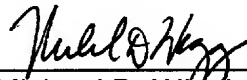
Therefore, Claim 24 is allowable for at least the above reasons. Claims 26-28 and 32-36 ultimately depend from Claim 24 and are allowable for at least similar reasons.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: January 19, 2007

By: 
Michael D. Wiggins
Reg. No. 34,754

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

MDW/mp